

REMARKS

Claims 1-16 and 18-20 are pending in this application.

Applicants have canceled claim 17. In addition, Applicants are submitting herewith a substitute specification. As explained below, these changes do not introduce any new matter.

In response to the objection to the specification, Applicants are submitting herewith a substitute specification prepared with the line spacing set at 1.5 lines. Applicants' undersigned representative states that the substitute specification does not introduce any new matter.

Regarding the requirement for a marked-up version of the original specification set forth in 37 C.F.R. § 1.125, Applicants note that the changes being made to the original specification involve only formatting matters. Accordingly, Applicants submit that there is no need for the submission of a marked-up version of the original specification.

In response to the objection to the claims, Applicants have prepared the "Listing of Claims" set forth above with the line spacing set at 1.5 lines. Accordingly, Applicants respectfully request that the objection to the claims be withdrawn.

As noted above, Applicants have canceled claim 17. Accordingly, the rejection of claim 17 under 35 U.S.C. § 101 as being directed to non-statutory subject matter is moot.

Applicants respectfully request reconsideration of the rejection of claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over *Mori* (U.S. Patent No. 6,089,765) in view of *Nosaki et al.* (U.S. Patent No. 5,673,373) ("*Nosaki*") (as noted above, claim 17 has been canceled herein). As explained below, the combination of *Mori* in view of *Nosaki* would not have suggested to one having ordinary skill in the art the subject matter defined in independent claims 1, 9, and 18-20.

Independent claim 1 defines a printer that includes, among other features, a judging portion, which judges whether the received printing job is set to have some secret or not, and

a selective holder. The selective holder refrains from holding the printing job as printing job data in the auxiliary memory device even if the set portion is set so that the printing job is still held as printing job data in an auxiliary memory device even after printing is completed, when the judging portion judges that the printing job is set to have some secret. The selective holder also holds the printing job as printing job data in the auxiliary memory device when the judging portion judges that the printing job is not set to have some secret and the set portion is set so that the printing job is still held as printing job data in the auxiliary memory device even after printing is completed.

The network system 1 shown in the *Mori* reference includes client computer 20 and printer 10, and print data is stored in print data storage device 44 of computer 20, *but not in printer 10*. If printer 10 requests that computer 20 resend the print data, computer 20 resends the print data stored in print data storage device 44 of printer 10 (see column 4, lines 4-14). As such, the process shown in Figures 4-6 of the *Mori* reference is executed by computer 20 (see column 6, lines 7-9). Consequently, computer 20 judges whether or not the subject print data is intended to be reprinted. Moreover, computer 20 does not judge whether or not the print data is set to have some secret or not, but rather computer 20 judges whether or not the print data is intended to be reprinted (see column 6, lines 25-29).

For at least the foregoing reasons, printer 10 and computer 20 shown in the *Mori* reference do not have the features of the printer defined in claim 1.

Another feature of the printer defined in claim 1 is that the printer includes a set portion in which whether or not a received printing job is held as printing job data in an auxiliary memory device even after printing of the received printing job is completed is set not for each printing job but comprehensively, this comprehensive setting being allowed to be performed from a client via a network. In support of the obviousness rejection, the Examiner

alleges that the *Nosaki* reference discloses that a memory print mode in print server 2 is set comprehensively and that this comprehensive setting is allowed to be performed from a client via a network. Applicants have reviewed the portions of the *Nosaki* reference cited by the Examiner, as well as the remainder of the reference, and have been unable to locate any description that supports the Examiner's characterization of the *Nosaki* reference relative the subject matter defined in claim 1. Thus, print server 2 shown in the *Nosaki* reference does not have the set portion feature of the printer defined in claim 1.

In view of the foregoing, the combination of the *Mori* reference with the *Nosaki* reference would not have resulted in a printer having the features defined in claim 1. Thus, the combination of the *Mori* reference with the *Nosaki* reference would not have suggested to one having ordinary skill in the art the subject matter defined in claim 1. The arguments set forth above regarding claim 1 apply equally to independent claims 9 and 18-20. Accordingly, independent claims 1, 9, and 18-20 are patentable under 35 U.S.C. § 103 over the combination of *Mori* in view of *Nosaki*. Claims 2-8, each of which ultimately depends from claim 1, and claims 10-16, each of which ultimately depends from claim 9, are likewise patentable under 35 U.S.C. § 103 over the combination of *Mori* in view of *Nosaki* for at least the same reasons set forth above regarding the applicable independent claim.

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of claims 1-16 and 18-20, and submit that these claims are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 749-6902. If any additional fees are due in connection with

Application No. 09/934,678
Amendment dated July 21, 2005
Response to Office Action mailed April 21, 2005

the filing of this paper, then the Commissioner is authorized to charge such fees to Deposit

Account No. 50-0805 (Order No. KYWAP004).

Respectfully submitted,
MARTINE PENILLA & GENCARELLA, L.L.P.

A handwritten signature in black ink, appearing to read 'P. B. Martine', with a long horizontal flourish extending to the right.

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